No. 98-657

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In The

Supreme Court of the United States

October Term, 1998

STATE STREET BANK AND TRUST COMPANY,

Petitioner,

v.

SIGNATURE FINANCIAL GROUP, INC.,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the definition of patentable subject matter in 35 U.S.C. § 101, which includes "any new and useful . . . machine," encompasses a data processing machine that produces a useful, concrete, and tangible result.

PARTIES TO THE PROCEEDING AND DISCLOSURE UNDER SUP.CT.R. 29.6

The petition accurately lists the parties to the proceeding. Respondent Signature Financial Group, Inc., a corporate defendant, has no parent companies, subsidiaries or affiliates that have issued shares to the public.

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STATEMENT OF THE CASE

Petitioner advances a single assertion – that the subject matter claimed in United States Patent No. 5,193,056 (the " '056 Patent") is the equivalent of abstract mathematics and, therefore, not directed to patentable subject matter under 35 U.S.C. § 101. The Federal Circuit, however, properly recognized that the claims of the '056 Patent, when construed in accordance with 35 U.S.C. § 112, ¶ 6, are directed to one of the explicitly enumerated categories of statutory subject matter contained in § 101 – namely, a new and useful machine. *State Street Bank and Trust Company v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1372, 47 USPQ 2d 1596, 1599-1600 (Fed. Cir. 1998).[1] The Federal Circuit also properly rejected the argument that a new and useful machine is abstract mathematics. 149 F.3d at 1373-74, App. A to Petition at A-5 to A-7. In reaching its conclusion, the Federal Circuit applied the plain language of § 101 and the teachings of this Court to conclude that a claim directed to a new machine that produces a useful, concrete and tangible result is statutory subject matter.

The patented invention relates generally to a new form of investment structure developed by Signature Financial Group, Inc. ("Signature"). Importantly, State Street Bank & Trust Company ("State Street") concedes that the claimed invention is not the financial concept *per se*, but rather a data processing system capable of administering the structure. *See* Petition at p. 4. In short, this

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[1] Cites to the Federal Circuit's Opinion in *State Street* will include a citation to the Appendix filed with the Petition for Writ of Certiorari ("Petition").

new and useful tool allows an administrator to monitor and record the financial information flow and make all calculations necessary to administer the financial services configuration. *State Street*, 149 F.3d at 1371, App. A to Petition at A-4.

In determining that the '056 Patent is directed to statutory subject matter, the Federal Circuit logically began by construing the claims. 149 F.3d at 1371, App. A to Petition at A-5. The claims are drafted in means plus function format as permitted by 35 U.S.C. § 112, ¶ 6. When read in reference to the detailed specification and figures, the data processing system includes a personal computer programmed with software that executes instructions to perform the various functions required for administering the financial services configuration. For example, claim 1 recites in clauses (a) through (g) specific structural elements, including a computer processor means and a storage means. *State Street*, 149 F.3d at 1371, App. A to Petition at A-5 to A-6.

The Federal Circuit explicitly rejected the district court's analysis, advanced here by State Street, that the claims could be viewed as directed to a process, with each "means" clause merely representing a step in the process. *Id.* Rather, when independent claim 1 is properly construed in accordance with 35 U.S.C. § 112,¶ 6 and the holdings of two *en banc* decisions of the Federal Circuit,[2]

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[2] *See In re Alappat*, 33 F.3d 1526, 1541, 31 USPQ 2d 1545, 1554 (Fed. Cir. 1994) (*en banc*) (when claims include means-plus-function elements, § 112, ¶ 6 must be applied in § 101 analysis); *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ 2d 1845, 1848 (Fed. Cir. 1994) (*en banc*) (under § 112, ¶ 6, means-plus-function

it is directed to a machine with the subject matter in the brackets representing the structure disclosed in the written description that corresponds to the respective "means" recited in the claims:

> (1) A data processing system[3] for managing a financial services configuration of a portfolio established as a partnership, each partner being one of a plurality of funds, comprising:
>
> (a) computer processor means [a personal computer including a CPU] for processing data;
>
> (b) storage means [a data disk] for storing data on a storage medium;

---

elements must be construed in light of the corresponding structure described in the patent's specification).

[3] A "data processing system" is defined in the art as "a device [a computer] capable of accepting data from some external source, processing the data in accordance with a set of prescribed operations, and outputting the results to some external recipient. In accordance with this definition, you might say that a computer is a *machine* that processes information and can be viewed as in Figure 1-1."

FIGURE 1-1

Data Processing System

=

Raw Data

↓

Data Processing Operation

↓

Useful Information

A.J. Haitling, L. Druffel, F. Hilbing, *Introduction to Computer Programming: A Problem Solving Approach,* at pp. 2-3 (1983). (Emphasis added.)

(c) first means [an arithmetic logic circuit configured to prepare the data disk to magnetically store selected data] for initializing the storage medium;

(d) second means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases or decreases based on specific input, allocate the results on a percentage basis, and store the output in a separate file] for processing data regarding assets in the portfolio and each of the funds from a previous day and data regarding increases or decreases in each of the funds [sic, funds'] assets and for allocating the percentage share that each fund holds in the portfolio;

(e) third means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily incremental income, expenses, and net realized gain or loss for the portfolio and for allocating such data among each fund;

(f) fourth means [an arithmetic logic circuit configured to retrieve information from a specific file, calculate incremental increases and decreases based on specific input, allocate the results on a percentage basis and store the output in a separate file] for processing data regarding daily net unrealized gain or loss for the portfolio and for allocating such data among each fund; and

(g) fifth means [an arithmetic logic circuit configured to retrieve information from specific files, calculate that information on an aggregate

> basis, and store the output in a separate file] for processing data regarding aggregate year-end income, expenses and capital gain or loss for the portfolio and each of the funds.

149 F.3d at 1371-72, App. A to Petition at A-5 to A-7 (bracketed information added by the Federal Circuit.)

Once the claims were properly construed as a machine, the Federal Circuit correctly concluded that the claims were directed to statutory subject matter. First, Judge Rich,[4] writing for a unanimous panel, noted that a "machine" is proper statutory subject under the plain terms of § 101. 149 F.3d at 1372, App. A to Petition at A-7. Next, he examined whether the claimed subject matter fell into any of the narrow, judicially-created exceptions. In holding that it did not, the Federal Circuit applied the fundamental principles announced by this Court's holdings on § 101 together with its own substantial body of precedent.

REASONS FOR DENYING THE PETITION

The Question Presented by State Street Is Hypothetical and Was Not Determinative of the Federal Circuit's Decision

State Street's entire argument for certiorari is based upon a flawed reading of the Federal Circuit's decision. State Street's arguments all incorrectly presume that the Federal Circuit held that the computer application of a

[4] It should be noted that Judge Rich was the co-author of the Patent Act of 1952.

mathematical algorithm to produce a useful result, without more, satisfies the requirements of § 101. Because this fundamental premise is inaccurate, the petition for writ of certiorari should be denied.

The Federal Circuit's holding itself is crystal clear. First, the Federal Circuit held that when the claims of the '056 Patent are properly construed, they are directed to a new "machine" and not a "process." *State Street*, 149 F. 3d at 1371-72, App. A to Petition at A-5 to A-7. Next, the Federal Circuit explained why this particular new machine is patentable subject matter under § 101.

> Today, we hold that the transformation of data, representing discrete dollar amounts *by a machine* through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result" – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

149 F.3d at 1373, App. A to Petition at A-10 (emphasis added).

The Federal Circuit's holding is specific and remarkably non-controversial: the application of an algorithm – the executing software interacting with a general purpose computer – as part of a new and useful machine – the data processing system – capable of administrating a particular financial services configuration, is patentable subject matter. Rather than challenge the specific holding, State Street distorts selected dicta to create an issue that

was not before the Federal Circuit. Consequently, the question posed by State Street is solely an academic question and granting the writ would bring before this Court a hypothetical issue that the Federal Circuit did not decide.

The Federal Circuit's Decision Properly Applied the Statute and This Court's Holdings

The Federal Circuit properly concluded that a new and useful machine that solves a practical problem by producing a concrete and tangible result is patentable subject matter under § 101. The Federal Circuit correctly distinguished abstract scientific principles that are not patentable – a mathematical formula standing alone – from claims that apply a scientific principle or algorithm to otherwise statutory subject matter to produce a new and useful result – a new machine capable of administering a financial services configuration. The Federal Circuit's decision was instructed by the language of the statute and this Court's decisions.

As this Court has explained, an analysis of patentable subject matter begins with the statute. *Diamond v. Diehr*, 450 U.S. 175, 182 (1981). Section 101 reads:

> Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101. This Court noted that the statute contained a simple, concise legislative mandate that a patent

may issue for "any new and useful process, machine, manufacture or composition of matter." *Diehr*, 450 U.S. at 182.

Noting the broad nature of the statute, this Court observed that Congress intended § 101 to include "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (*quoting* S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)). This Court further recognized that, by casting statutory subject matter in broad terms, Congress was fulfilling its duty under the United States Constitution. *Chakrabarty*, 447 U.S. at 315 ("The subject-matter provisions of the patent law have been cast in broad terms to *fulfill the constitutional* and statutory *goal of promoting 'the Progress of Science and the useful Arts'* with all that means for the social and economic benefits envisioned by Jefferson.") (*quoting* U.S. Const. Art. I, § 8, cl. 8.) (emphasis added). In recognition of these principles, the Federal Circuit explicitly reiterated this Court's warning in construing § 101: "Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations." *State Street*, 149 F.3d at 1373, App. A to Petition at A-8 to A-9; *see also Diehr*, 450 U.S. at 182 ("[I]n dealing with the patent laws, we have more than once cautioned that 'courts should not read into the patent laws limitations and conditions which the legislature has not expressed.' ").

State Street's entire argument violates these fundamental tenets. State Street does not challenge the Federal Circuit's finding that the claims of the '056 Patent are directed to a new and useful machine that produces a

concrete and tangible result. Rather, State Street contends that this particular new and useful machine is not patentable subject matter. In short, if this Court adopts State Street's argument, then the language in the statute – "any new and useful . . . machine" – would not be applied to any new and useful machine. Rather, this Court would be creating a brand new statutory exception not justified by the plain terms of the statute or legislative history.

The Federal Circuit recognized that this Court has identified only three categories "of subject matter that are unpatentable, namely 'laws of nature, natural phenomena, and abstract ideas.' "[5] *State Street*, 149 F.3d at 1373, App. A to Petition at A-9 (*quoting Diehr*, 450 U.S. at 185). This Court explained the rationale behind this narrow limitation:

> "[A] new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that $E=mc^2$, nor could Newton have patented the law of gravity. Such discoveries are manifestations of . . . nature, free to all men and reserved exclusively to none."

Diehr, 450 U.S. at 185 (*quoting Chakrabarty*, 447 U.S. at 309.)

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[5] State Street emphasizes this Court's holdings in *Parker v. Flook*, 437 U.S. 584 (1978) and *Gottschalk v. Benson*, 409 U.S. 63 (1972). But in *Diehr*, this Court explained that those decisions "stand for no more than these long-established principles" that abstract ideas and natural phenomena are not patentable. *Diehr*, 450 U.S. at 185 (*citing Chakrabarty*, 447 U.S. at 309 and *Funk Bros. Seed & Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948)).

In applying that rationale to mathematical algorithms, this Court recognized that a mathematical formula may describe a law of nature, a scientific truth or an abstract idea. Importantly, this Court also recognized that mathematics may be used to describe steps of a statutory method or elements of a statutory machine. *Id.* at 188; *see also Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1056, 22 USPQ 2d 1033, 1035 (Fed. Cir. 1993). The crucial distinction, properly recognized and applied by Judge Rich below, is whether each claim, when viewed as a whole, recites a mathematical formula either in the abstract or as part of an invention, such as a machine, within § 101. *Id.* at 192; *see also In re Alappat*, 33 F.3d at 1545, 31 USPQ 2d at 1558 ("a computer . . . is apparatus, not mathematics.").

Measuring the claims of the '056 Patent against the plain text of § 101 and the fundamental principles in *Diehr* and *Chakrabarty*, the Federal Circuit concluded that the claims are directed to patentable subject matter. In reaching its conclusion, the Federal Circuit recognized the crucial distinction between abstract science that is not patentable subject matter – pure mathematics – and applied science to achieve a particular, useful result – programming a computer to create a new machine to solve a particular problem. *State Street*, 149 F.3d at 1373-74, App. A to Petition at A-9 to A-10.

State Street attempts to avoid this distinction by improperly focusing solely on the part of the claim that can be expressed as an algorithm while ignoring other parts of the claim – such as the "computer processor means" and the "storage means" – that clearly define apparatus to implement a specific functionality. State

Street's approach was rejected by this Court in *Diehr*: "It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the [§ 101] analysis." 450 U.S. at 188. As the Federal Circuit correctly observed, the focus in any statutory subject matter analysis must be on the "claim as a whole." *Diehr*, 450 U.S. at 192; *Alappat*, 33 F.3d at 1543, 31 USPQ 2d at 1557. When the claims of the '056 Patent are viewed as a whole, they are clearly directed to a new and useful machine capable of solving a practical problem by producing a tangible and concrete result. According to the plain terms of the statute and this Court's teachings, such claims are statutory.

The Federal Circuit also examined its own substantial body of established precedent to reach the result below. Specifically, the Federal Circuit examined its precedent since *Diehr* in 1981 and applied the holdings and logic in those cases to the technology and claims involved in the '056 Patent.[6] *State Street*, 149 F.3d at 1373-75, App. A to Petition at A-10 to A-13. That precedent clearly confirmed that claims directed to an admittedly new and useful machine capable of producing a concrete and tangible result to solve a practical problem meet the requirements of § 101.

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[6] The decisions analyzed included, *inter alia*, *In re Alappat*, 33 F.3d 1526, 31 USPQ 2d 1545 (Fed. Cir. 1994) (*en banc*); *In re Warmerdam*, 33 F.3d 1354, 31 USPQ 2d 1754 (Fed. Cir. 1994); *Arrhythmia Research Technology Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992); and *In re Iwahashi*, 888 F.2d 1370, 12 USPQ 2d 1908 (Fed. Cir. 1989).

State Street also makes passing reference to the so-called "business method exception" as a basis for its conclusion that the claims are not directed to statutory subject matter. Petition at p. 5. The Federal Circuit, however, correctly took the "opportunity to put this ill-conceived exception to rest." *State Street*, 149 F.3d at 1375, App. A to Petition at A-13. Judge Rich noted that the business method exception "has never been invoked by [the Federal Circuit], or the CCPA, to deem an invention unpatentable" and that the U.S. Patent and Trademark Office Guidelines specifically reject use of the exception. 149 F.3d at 1375-77, App. A to Petition at A-14 to A-17 (*citing* Examination Guidelines, 61 Fed. Reg. 7478, 7479 (1996)).

State Street's "Impact Statement" Directly Contradicts the Policies of the Patent Act

State Street argues that it would be "unwise and unfair to now subject to the burdens of the patent system activities that have long been outside its ambit" and that if "such a fundamental change is to be made, it is Congress that should do so."[7] Petition at p. 11. State Street

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[7] State Street's inference that the Federal Circuit's decision is a drastic, unwanted change in the industry is refuted by the facts. At the time of the decision, there were already over 20,000 financial-instrument patents that had issued. *See* Victoria Slind-Flor, *Patents For Financial Programs OK*, the National Law Journal, Aug. 10, 1998, at p. 1, col. 1. Indeed, the ease with which the financial services industry has embraced the patent system is demonstrated by the fact that a unit of State Street recently received a patent for a data processing system that helps select stocks and construct portfolios. *See* Pui-Wing Tam, *What's Next*

has it exactly backwards. Congress has already provided in § 101 that "any new and useful . . . machine" is patentable. As this Court has recognized, it would be inappropriate for the Court to entertain argument regarding whether it would be "unwise and unfair" to limit otherwise statutory subject matter on policy grounds:

> The choice we are urged to make is a matter of high policy for resolution within the legislative process after the kind of investigation, examination, and study that legislative bodies can provide and courts cannot. That process involves the balancing of competing values and interests, which in our democratic system is the business of elected representatives. Whatever their validity, the contentions now pressed on us should be addressed to the political branches of the Government, the Congress and the Executive, and not to the courts.

Chakrabarty, 447 U.S. at 317.

A computer is a well-known piece of apparatus that is patentable under § 101 just like any other tool or machine. When that machine is programmed to perform a particular useful function that produces a concrete and tangible result, it becomes a new and useful machine. *See Alappat*, 33 F.3d at 1545, USPQ 2d at 1557. State Street, unable to avoid this logical conclusion, attacks the patent system itself and diverts the analysis to theoretical dangers of patent protection in the financial services industry. In short, State Street argues that the financial services industry is somehow different from all other industries

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Getting Patents For Cold Calls, Wall Street Journal, Nov. 2, 1998, at C1, col. 1.

and should be sheltered from imagined harm caused by allowing inventors in this industry to obtain patents. This argument concludes that no innovation, no matter how novel, unique, unobvious and useful, warrants patent protection if it affects the financial services industry.

This conclusion, however, would directly undermine the policy behind the Patent Act. As explained by the Federal Circuit, the incentives offered by patent protection have served this country well as an engine for fostering innovation:

> Law and public policy intertwine in embracing new fields in the scope of section 101. Patent law has nicely fostered technological advance in the United States, for its principles are particularly suited to a free market system: it requires neither governmental intrusion nor federal funds to provide the incentive for industrial innovation; the innovation incentive is the direct consequence of the patent grant. I know of no major technological advance, no new industry or evolving technology, that has not participated in the patent system. It is estimated that 85-90% of the world's technology is disclosed only in patent documents. Justice Story's words at the threshold of our nation's industrialization have been reinforced by experience:
>
> > Patents for inventions are now treated as a just reward to ingenious men, and as highly beneficial to the public, not only by holding out suitable encouragement to genius and talents and enterprise; but as ultimately securing to the whole community great advantages from the free communication of secrets, and processes, and machinery, which may be most important to all the

> great interests of society, to agriculture, to commerce and to manufactures, as well as to the cause of science and art.

Alappat, 33 F.3d at 1570-71, 31 USPQ 2d at 1579 (*quoting Blanchard v. Sprague*, 3 F.Cas. 648, 650 (C.C.D. Mass. 1839)). The Federal Circuit's decision is squarely in line with public policy.

State Street's argument that Congress should act to extend patent protection to computer-implemented inventions in the financial services industry is invalid. Congress has purposely acted by choosing the broad language of § 101. This Court should not read limitations into the statute where none are present or intended. *Chakrabarty*, 447 U.S. at 308. Indeed, if an entire industry or technology is to be carved out of § 101, it is Congress that must do so. *Id.* at 317.

Finally, State Street's contention that the practical consequences of the decision "are of an unprecedently broad scope" is a litigant's exaggeration. Petition at p. 6. The Federal Circuit's decision addressed only the narrow issue of patentable subject matter under § 101. Section 101 is merely " '[t]he first door which must be opened on the difficult path to patentability[.]' " *State Street*, 149 F.3d at 1372 & n. 2, App. A to Petition at A-8 & n. 2. (*quoting In re Bergy*, 597 F.2d 952, 960, 201 USPQ 352, 360 (CCPA 1979)). Of course, to secure a patent, the claimed invention must also meet the other requirements of Title 35, including §§ 102 (novelty), 103 (nonobviousness) and 112, ¶¶ 1 and 2 (enablement and particularity). These provisions are more than adequate to guard against the theoretical dangers raised by State Street.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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